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TO: Commissioner for Patents  
Attn: Examiner C. Nguyen  
Patent Examining Corps  
Facsimile Center  
Washington, D.C. 20231

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Applicant:	Neelakantan Sundaresan
Serial No.:	09/323,605
Filed:	June 1, 1999
Group Art Unit:	3625
Our Ref. No.:	AM999007

Please charge all fees to Deposit Account No. 09-0441 of IBM Corporation, the assignee of the present application.

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Due Date: February 23, 2003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Neelajantan Sundaresan	Examiner:	C. Nguyen
Serial No.:	09/323,605	Group Art Unit:	3625
Filed:	June 1, 1999	Docket:	AM999007 (ADM)
Title:	METHOD AND SYSTEM FOR CO-BROWSING IN ELECTRONIC COMMERCE		

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Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

We are transmitting herewith the attached:

- ☒ Transmittal sheet, in duplicate, containing a Certificate of Mailing or Transmission under 37 CFR 1.8.
- ☒ BRIEF OF APPELLANT (in triplicate).
- ☒ Please charge \$320.00 to Deposit Account No. 09-0441 for the Appeal Brief filing fee.

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Name: George H. Gates  
Reg. No.: 33,500  
GHG/lo

Due Date: February 23, 2003

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:	)	
	)	
Inventor: Neelakantan Sundaresan	)	Examiner: C. Nguyen
	)	
Serial #: 09/323,605	)	Group Art Unit: 3625
	)	
Filed: June 1, 1999	)	Appeal No.: _____
Title: <u>METHOD AND SYSTEM FOR</u>	)	
<u>CO-BROWSING IN ELECTRONIC COMMERCE</u>	)	

**BRIEF OF APPELLANT**

Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

In accordance with 37 CFR §1.192, Appellant hereby submits the Appellant's Brief on Appeal from the final rejection in the above-identified application, in triplicate, as set forth in the Office Action dated September 27, 2002.

Please charge the amount of \$320 to cover the required fee for filing this Appeal Brief as set forth under 37 CFR §1.17(c) to Deposit Account No. 09-0441 of IBM Corporation, the assignee of the present application. Also, please charge any additional fees or credit any overpayments to Deposit Account No. 09-0441.

**I. REAL PARTY IN INTEREST**

The real party in interest is IBM Corporation, the assignee of the present application.

## II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences for the above-referenced patent application.

## III. STATUS OF CLAIMS

Claims 1-3, 6-13, 16-23 and 26-30 are pending in the application. Claims 4, 5, 14, 15, 24 and 25 have previously been canceled. Claims 1-3, 6-13, 16-23, and 26-30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Fernandes in view of Hodges et al.'s book on multimedia computing, 1993 (Hodges), and further in view of Bull et al., U.S. Patent No. 5,901,287 (Bull), and Sonnenreich et al., U.S. Patent No. 5,974,446 (Sonnenreich), and these rejections are being appealed.

## IV. STATUS OF AMENDMENTS

No amendments to the claims have been made subsequent to the final Office Action.

## V. SUMMARY OF THE INVENTION

Briefly, Appellant's invention, as recited in independent claims 1, 11, and 21, is generally directed to a method, apparatus and computer program carrier for providing co-browsing by users shopping over a computer network (specification at page 3, lines 4-5). The method comprises (a) providing a network site offering items for sale, (b) monitoring the browsing patterns of a first user of the network site and of a second user of the network site, (c) identifying a common browsing pattern of the first and second users, (d) informing the users of the common browsing pattern, (e) providing to the first user of the network site capability to inform the network site of interest in co-browsing with the second user, (f) providing to the second user of the network site capability to inform the network site of interest in co-browsing with the first user, and (g) providing a capability for communication between the interested first and second users while they continue to shop on the network site (specification at page 3, lines 4-5, and page 4, lines 1-5). Further features of the invention are recited in dependent claims. For example, claim 2 adds the feature: providing users with a window for interfacing with the network site, wherein the window comprises a first pane that displays information relating to items for sale and a second pane that displays content of the communication between the first and second user (specification at page 3, lines 14-21).

## VI. ISSUES PRESENTED FOR REVIEW

Whether claims 1-3, 6-13, 16-23, and 26-30 are unpatentable under 35 U.S.C. § 103(a) as being rendered obvious by Fernandes, "Businesses have a chat," Business Journal-San Jose, v15 N9 p1, 06/30/97 (Fernandes), in view of Hodges et al.'s book on multimedia computing, 1993 (Hodges), and further in view of Bull et al., U.S. Patent No. 5,901,287 (Bull), and Sonnenreich et al., U.S. Patent No. 5,974,446 (Sonnenreich).

## VII. GROUPING OF CLAIMS

The rejected claims do not stand or fall together. Each claim group is independently patentable. Separate arguments for the patentability of each claim group are provided below.

## VIII. ARGUMENTS

### A. The Independent Claims Are Patentable Over The Prior Art

The Examiner provides vague indications (no identification of specific page and line numbers) at pages 6-7 of the Office Action of references that allegedly meet each of elements (a) through (g) of claim 1. Review of the cited references, however, shows that the elements cannot be found in these references. Accordingly, the Examiner has not made out a *prima facie* case of obviousness because it has not been shown that each element of the claims is taught or suggested in the prior art.

Appellant asserts that the Examiner fails to address key limitations of Appellant's claims. Specifically, nowhere does the Examiner address the limitations of Appellant's claims directed to:

- providing co-browsing by users shopping over a computer network;
- identifying a common browsing pattern of a first user and of a second user of a network site offering items for sale;
- informing the users of the common browsing pattern;
- providing to the first and second users of the network site capability to inform the network site of interest in co-browsing with the other user;

- providing a capability for communication between the interested first and second users while they continue to shop on the network site.

Most notably absent from the record is a prior art reference that teaches elements (d)-(f) of claim 1. The Examiner cites Bull as teaching element (d), informing the users of the common browsing pattern, because Bull teaches "browsing patterns of the user are analyzed and these patterns update profiles". The updating of user profiles as taught in Bull, however, is not the same as informing the users of a common browsing pattern. Bull is directed at analysis of user browsing patterns to update profiles for the purpose of tailoring advertisements and coupons to individual user profiles (see, e.g., lines column 8, lines 23-30). This does not teach or suggest providing information about user browsing patterns to the other concurrent users. Moreover, Bull teaches updating the user profile with data relating to browsing patterns "so that when they next use the information aggregation and synthesization system, the nominated searches will be customized to their individual desires" (column 4, lines 30-33). This statement makes it clear that Bull does not contemplate or suggest using the data regarding browsing patterns to inform other users who are shopping at the network site, let alone to do so "while they continue to shop on the network site".

In addition, not a single reference is cited as teaching elements (e) and (f) of claim 1, which relate to providing to the first and second users of the network site capability to inform the network site of interest in co-browsing with the other user (see page 6 of Office Action dated September 27, 2002). To meet the objective of providing co-browsing by users shopping over a computer network, the users must be given the opportunity to inform the network site of this interest in co-browsing so that they can make use of it. To make out a *prima facie* case for obviousness, the Examiner must show that the prior art teaches or suggests all limitations of the claim. In *re* Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In *re* Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). At the very least, the obviousness rejection cannot stand given that the Examiner has not identified a prior art reference teaching elements (e) and (f) of claim 1.

Moreover, only portions, at best, of the remaining elements are taught by the cited references. The claimed method is directed at users shopping on a network site. To provide the opportunity for co-browsing with other shoppers sharing similar interests, the network site first

identifies those users exhibiting a common browsing pattern, then informs them of the common browsing, and then invites them to indicate their interest in co-browsing with the other user(s) showing the same interests. Despite combining four different references to support the obviousness rejection, the Examiner has not shown how the prior art taught or suggested this method.

For example, element (c) of claim 1 is directed to "identifying a common browsing pattern of the first and second users". The Examiner cites Bull as teaching this element, by referring to the same phrase cited for element (d): "browsing patterns of the user are analyzed and these patterns update profiles". While Bull may teach analyzing user browsing patterns, Bull does not teach identifying common browsing patterns of a first and second user. Because the objective in Bull differs from that of the claimed invention, as Bull analyses browsing patterns of a particular user to tailor a session to that same individual user, there is no suggestion in Bull to modify its teachings to arrive at element (c) of Appellant's claim 1.

Likewise, element (g) of claim 1 is not fully met by the cited references. This element is directed to "providing a capability for communication between the interested first and second users while they continue to shop on the network site." The Examiner cites Fernandes and Sonnenreich as allegedly teaching this element. Fernandes is cited as teaching users who communicate in real-time using a computer keyboard and browsing on the world wide web while having a conversation. This falls short of providing capability for communication between interested users ("interested users" referring back to users who have indicated their interest in co-browsing after being informed by the network site of others showing a common browsing pattern) while they continue to shop on the network site. Fernandes does not teach providing this capability to interested users while they continue to shop on the network site. Instead, Fernandes teaches communication in the context of a meeting in the business world or via on-line chat rooms.

Sonnenreich is even further removed from the context of shopping on a network site and from co-browsing initiated by the network site on the basis of identified common browsing patterns. Sonnenreich is directed to an internet based distance learning system and provides for communication between clients who have first elected to become members of a user group based on pre-selected information topics. Sonnenreich teaches away from Appellant's invention because it suggests that real-time intercommunication amongst users must be set up within a group of users

who have first elected to become members of a group, rather than having the opportunity for communication initiated by the network site based on monitoring of the users' common browsing patterns.

Thus, Appellant submits that independent claims 1, 11, and 21 are allowable over the cited references.

B. The Dependent Claims Are Patentable Over The Prior Art

Dependent claims 2-10, 12-20, and 22-30 are also submitted to be allowable over the cited references in the same manner as independent claims 1, 11, and 21, because they are dependent on independent claims 1, 11, and 21, respectively, and thus contain all the limitations of the independent claims. In addition, dependent claims 2-10, 12-20, and 22-30 recite a number of additional novel elements not shown by the cited references.

With regard to dependent claims 2, 12 and 22, these claims recite further providing the users with a window for interfacing with the network site, wherein the window comprises a first pane that displays information relating to items for sale and a second pane that displays content of the communication between the first and second user. At page 8 of the Office Action, fourth paragraph, it is alleged that Hodges, at pages 166-167, "clearly disclose a collaborative browsing case . . . wherein voice, video, and shared graphics and data were used simultaneously in different panes." Hodges teaches a shared-data mode in which the user and a realtor can view the same records simultaneously, while also talking on the phone. Hodges does not teach a second pane that displays content of the communication between the first and second user. In Hodges, the content of the communication is shared orally via the telephone and is not displayed in a window.

With regard to the remaining dependent claims, no references are cited as disclosing these features. Instead, it is alleged that "it would be obvious for one with ordinary skill in the art to provide such information within means of available communications". Appellant respectfully notes that this type of conclusory statement regarding the general knowledge in the art is not sufficient grounds for an obviousness rejection. In re Lee, 61 USPQ2d 1430 (Fed. Cir. 2002).

Thus, the Appellant submits that dependent claims 2-10, 12-20, and 22-30 are also allowable over the cited references.



C. Conclusion

In light of the above arguments, Appellant respectfully submits that the cited references do not anticipate nor render obvious the claimed invention. More specifically, Appellant's claims recite novel physical features which patentably distinguish over any and all references under 35 U.S.C. §§ 102 and 103. As a result, a decision by the Board of Patent Appeals and Interferences reversing the Examiner and directing allowance of the pending claims in the subject application is respectfully solicited.


Respectfully submitted,

GATES & COOPER LLP

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G&C 30879.73-US-01

## APPENDIX

1. A method for providing co-browsing by users shopping over a computer network, comprising the steps of:
  - (a) providing a network site offering items for sale;
  - (b) monitoring the browsing patterns of a first user of the network site and of a second user of the network site;
  - (c) identifying a common browsing pattern of the first and second users;
  - (d) informing the users of the common browsing pattern;
  - (e) providing to the first user of the network site capability to inform the network site of interest in co-browsing with the second user;
  - (f) providing to the second user of the network site capability to inform the network site of interest in co-browsing with the first user; and
  - (g) providing a capability for communication between the interested first and second users while they continue to shop on the network site.
2. The method of claim 1, further comprising providing the users with a window for interfacing with the network site, wherein the window comprises a first pane that displays information relating to items for sale and a second pane that displays content of the communication between the first and second user.
3. The method of claim 1, wherein the capability for communication comprises a proxy server that protects identity of the users.

4. (Canceled)

5. (Canceled)

6. The method of claim 1, further comprising providing the first user with capability to inform the network site of subject matter of interest to the user.

7. The method of claim 6, wherein the second user is selected based on characteristics the second user shares with the first user.

8. The method of claim 7, further comprising notifying the second user of the characteristics shared with the first user.

9. The method of claim 7, wherein the characteristics include the subject matter of interest to the user.

10. The method of claim 1, wherein the capability to inform the network site of interest in co-browsing comprises capability to inform the network site of conditions required for co-browsing.

11. An apparatus for providing co-browsing by users shopping over a network, comprising:

(a) an electronic commerce server connected to the network for offering items for sale; and

(b) a co-browsing facility, provided by the electronic commerce server, that allows a first user that is browsing the items for sale to conditionally know whether a second user is also browsing the items for sale and then provides a communication medium for a conversation between the first and second users via the electronic commerce server while the first and second users both continue to browse the items for sale on the network site, wherein the electronic commerce server is capable of monitoring the browsing pattern of at least one of the first or second users, and wherein the electronic commerce server is further capable of identifying at least two users of a common browsing pattern and informing the at least two users of the common browsing pattern.

12. The apparatus of claim 11, wherein the co-browsing facility comprises a window for interfacing with the network site, wherein the window comprises a first pane that displays information relating to items for sale and a second pane that displays content of the communication between the first and second user.

13. The apparatus of claim 11, wherein the communication medium comprises a proxy server that protects identity of the users.

14. (Canceled)

15. (Canceled)

16. The apparatus of claim 11, wherein the electronic commerce server provides the first user with capability to inform the server of subject matter of interest to the user.

17. The apparatus of claim 16, wherein the second user is selected based on characteristics the second user shares with the first user.

18. The apparatus of claim 17, wherein the server notifies the second user of the characteristics shared with the first user.

19. The apparatus of claim 17, wherein the characteristics include the subject matter of interest to the user.

20. The apparatus of claim 11, wherein the co-browsing facility comprises capability to inform the network site of conditions required for co-browsing.

21. An article of manufacture comprising a computer program carrier readable by a computer and embodying one or more instructions executable by the computer to perform method steps for:

- (a) providing a network site offering items for sale;
- (b) monitoring the browsing patterns of a first user of the network site and of a second user of the network site;
- (c) identifying a common browsing pattern of the first and second users;

- (d) informing the users of the common browsing pattern;
- (e) providing to the first user of the network site capability to inform the network site of interest in co-browsing with the second user;
- (f) providing to the second user of the network site capability to inform the network site of interest in co-browsing with the first user; and
- (g) providing a capability for communication between the interested first and second users while they continue to shop on the network site.

22. The article of manufacture of claim 21, wherein the method further comprises providing the users with a window for interfacing with the network site, wherein the window comprises a first pane that displays information relating to items for sale and a second pane that displays content of the communication between the first and second user.

23. The article of manufacture of claim 21, wherein the capability for communication comprises a proxy server that protects identity of the users.

24. (Canceled)

25. (Canceled)

26. The article of manufacture of claim 21, wherein the method further comprises providing the first user with capability to inform the network site of subject matter of interest to the user.

27. The article of manufacture of claim 26, wherein the second user is selected based on characteristics the second user shares with the first user.

28. The article of manufacture of claim 27, wherein the method further comprises notifying the second user of the characteristics shared with the first user.

29. The article of manufacture of claim 27, wherein the characteristics include the subject matter of interest to the user.

30. The article of manufacture of claim 21, wherein the capability to inform the network site of interest in co-browsing comprises capability to inform the network site of conditions required for co-browsing.